

Serial No.: 10/722,167
Docket No.: 101-R001
Amendment dated May 4, 2007
Reply to the Office Action of February 5, 2007

REMARKS

Introduction

Upon entry of the foregoing amendment, claims 1-21, 23-25 and 29-33 are pending in the application. Claims 1-20 are allowed. Claim 21 has been amended to correct a typographical error. No new matter is being presented. In view of the following remarks, reconsideration and allowance of all the pending claims are requested.

Objections

Claim Objections

Claims 21, 23, and 24 are objected to due to informalities. Specifically, Claim 21 was objected to because of a minor typographical error. Claims 23 and 24 depend from Claim 21. In response to the objection that in Claim 21 at Line 11, "so" should be --to--, Applicant has made the necessary amendment as reflected in the "Amendments to the Claims" section of this paper. Accordingly, Applicant respectfully requests withdrawal of this objection.

Rejection under 35 USC §112

Claims 21, 23-26, and 29-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserts that Claims 21, 23-26, and 29-33 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The language at issue is: "a surface potential charging unit to expose the surface of the photosensitive drum" as recited in Claim 21, Line 5; Claim 25, Line 5; Claim 29, Line 5 and Claim 32, Line 5 as well as the language "a pre-transfer exposing device...to expose a surface of a photosensitive member" as recited in Claim 33, Lines 1-4. Applicant respectfully submits that the rejected language is supported by the prior patent and the current specification and requests that the Examiner consider the following.

Serial No.: 10/722,167
Docket No.: 101-R001
Amendment dated May 4, 2007
Reply to the Office Action of February 5, 2007

Regarding the language: "a surface potential charging unit to expose the surface of the photosensitive drum," as recited in Claim 21, Line 5; Claim 25, Line 5; Claim 29, Line 5 and Claim 32, Line 5, Applicant submits the following:

It is noted that the Examiner refers to the surface potential changing unit as a "surface potential charging unit." It should be noted that the claim language at issue actually recites a "surface potential changing unit." As such, the merits of the Examiner's rejection are somewhat altered. However, and in the interest of expediting prosecution, Applicant submits the following:

The phrase "a surface potential changing unit", refers to the pre-transfer lamp or "PTL", which lowers the potential of the toner coated on the photosensitive drum by exposing the drum surface to light of 650nm wavelength generated by the PTL, as disclosed in Column 4, Line 65-Column 5, Line 1. Given that the PTL lowers and thereby changes the potential of the toner coat and ultimately the surface of the photosensitive drum, it is reasonable and well within the scope of the disclosure to refer to the PTL as a surface potential changing unit that exposes the surface of the photosensitive drum to light.

Although not particularly addressed by the Examiner, the remaining claim language is also supported in the prior patent in Column 6, Lines 30-36. Specifically, the PTL or surface potential changing unit includes a light emitting element or "LED" and a light guide member.

Regarding the language, "a pre-transfer exposing device...to expose a surface of a photosensitive member" as recited in Claim 33, Lines 1-4, Applicant submits the following:

The phrase "pre-transfer exposing device" refers to the pre-transfer lamp or "PTL", which exposes the photosensitive drum to light of 650nm wavelength as disclosed in Column 4, Line 65-Column 5, Line 1. Since the lamp or PTL exposes the drum to light, it is correct to refer to the light as an exposing device. Thus, Applicant submits that the language rejected by the Examiner, "a pre-transfer exposing device" is supported by a pre-transfer light that exposes the drum to light.

Given that the language of Claims 21, 25, 29, 32 and 33 has been evidenced to be wholly supported by the prior patent, Applicant respectfully requests withdrawal of the §112

Serial No.: 10/722,167
Docket No.: 101-R001
Amendment dated May 4, 2007
Reply to the Office Action of February 5, 2007

Rejection of independent Claims 21, 25, 29, 32 and 33 as well as corresponding dependent Claims 23, 24, 26, 30 and 31.

Rejection under 35 USC §251

Claims 21, 23-26, and 29-33 have been rejected under 35 U.S.C. §251 as being based upon new matter added to the patent for which reissue is sought.

Applicant notes that the §251 Rejections stem from the subject matter addressed by the above §112 Rejections, which are fully addressed above and will, therefore, be summarized. The phrase "a surface potential changing unit", refers to the pre-transfer lamp or "PTL", which lowers the potential of the toner coated on the photosensitive drum by exposing the drum surface to light of 650nm wavelength generated by the PTL, as disclosed in Column 4, Line 65-Column 5, Line 1. The phrase "pre-transfer exposing device" refers to the pre-transfer lamp or "PTL", which exposes the photosensitive drum to light of 650nm wavelength as disclosed in Column 4, Line 65-Column 5, Line 1.

Applicant respectfully submits that the language rejected by the Examiner is supported by the prior patent and requests withdrawal of the §251 Rejection. Furthermore, since no rejections of Claims 21, 23-26 and 29-33 have been made based on any prior art of record, allowance of these claims is respectfully requested.

Rejection under 35 USC §102

Claims 33 is rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,561,761 to Fox (hereinafter "Fox"). The Examiner alleges that Fox discloses a charge erase device (12), which reads on a light guide member, as shown in Figure 2, to spread received light in a scan direction of the photosensitive member (15) and to collect the received light (from lamp 78) in a direction perpendicular to the scan direction. However, Claim 33 actually recites "A pre-transfer exposing device used with an image forming apparatus to expose a surface of a photosensitive member in the image forming apparatus to light in order to change an electric potential of the surface of the photosensitive member, the pre-transfer exposure device comprising a light guide member to spread received light in a scan direction of the

Serial No.: 10/722,167
Docket No.: 101-R001
Amendment dated May 4, 2007
Reply to the Office Action of February 5, 2007

photosensitive member and to collect the received light in a direction perpendicular to the scan direction."

Applicant respectfully traverses the rejection based on the fact that the Examiner fails to show that all of the limitations of Claim 33 are anticipated. Specifically, the Examiner does not address limitations contained in the preamble, which are referred to in the body of the claim and therefore incorporated into the body of the claim. By referring to the photosensitive member within the body of the claim, other limitations of the preamble must be given full effect.

MPEP 2111.02 recites: "[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

The limitations of Claim 33 are largely contained within the preamble, which recites a pre-transfer exposing device, an image forming apparatus, an electric potential and their cooperative relationships. The Examiner does not address any of these limitations in the rejection of Claim 33. As such, Applicant is not given a fair opportunity to respond to the Office Action. Therefore, a final rejection would be improper. Moreover, Fox does not teach or suggest each of the features recited in the preamble of Claim 33, as provided above, or in the body of Claim 33, as provided below.

With respect to the limitations that were actually addressed by the Examiner in the body of Claim 33, as best that can be understood by Applicant from this broad rejection, the Examiner relies on Fox to illustrate "a light guide member, as shown in figure 2 to spread received light in a scan direction of the photosensitive member..." However, Figure 2 of Fox illustrates a charge erase device (12) that captures and transmits light (see Column 3, Line 60-Column 4, Line 23). In fact, it is evident from Figure 2 of Fox that the light exit surface of the charge erase device (12) is flat and therefore does not spread exiting light, which is discernible from Figure 5 of the present general inventive concept illustrating a light exit surface of the light guide (305) facing

Serial No.: 10/722,167
Docket No.: 101-R001
Amendment dated May 4, 2007
Reply to the Office Action of February 5, 2007

the photosensitive member (302) that is shaped to spread light. Thus, the Fox charge erase device (12) does not disclose "a light guide member to spread received light in a scan direction of the photosensitive member," as recited in Claim 33 and therefore cannot anticipate Claim 33.

In order for a document to anticipate a claim, the document must teach every element of the claim. MPEP 2131 states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). "The elements must be arranged as required by the claim..." In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Further, in the event that the Office Action is relying on the theory of inherency in any manner, "the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See also MPEP 2112. Accordingly, since Fox does not teach or suggest each of the features recited in claim 33, it is respectfully submitted that this document cannot be properly used to reject these claims as submitted in the Office action mailed 2/5/2007.

Accordingly, given the lack of anticipation of all of the limitations of Claim 33, Applicant respectfully requests withdrawal of the §102 Rejection. Applicant further submits that Claim 33 is allowable over the prior art of record, and allowance of this claim is earnestly solicited.

Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

Serial No.: 10/722,167
Docket No.: 101-R001
Amendment dated May 4, 2007
Reply to the Office Action of February 5, 2007

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 502827.

Respectfully submitted,

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